REMARKS/ARGUMENTS

In response to the above-identified Office Action, claims 1-13 remain pending in the present invention.

For the reasons set forth more fully below, Applicant respectfully submits that the present claims are allowable. Consequently, reconsideration, allowance and passage to issue of the present application are respectfully requested.

The Examiner rejected claims 1, 2, 3, 5, 6, 7, 8, 9, 11, 12, and 13 under 35 U.S.C. 102(b) as being anticipated by Kawan et al ("Kawan") and rejected claims 4 and 10 under 35 U.S.C. 103(a) as being unpatentable over Kawan in view of Ryan et al ("Ryan"). The Examiner also rejected claims 1 and 8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 36 of U.S. Patent 6,237,029. Applicant respectfully disagrees with the rejections.

Independent claim 1 recites the utilization of adaptive silicon as a hardware foundation of an electronic product and a required procurement of a digitation file to establish a hardware designation and software application for the adaptive silicon to provide the electronic product. Independent claim 8 recites the formation of an electronic product as an adaptive silicon portion structured for operation by a digitation file and the offering of the electronic product as two separate consumer items, the adaptive silicon portion and the digitation file, wherein the digitation file bears a higher percentage of a total cost of the electronic product. In the rejection of independent claims 1 and 8, the Examiner points to Kawan's disclosure in col. 10, lines 30-53. The teaching of Kawan in this cited section describes the use of a programmable gate array (PGA) in a computer system of a telephone-computer that provides a means for dynamically reconfiguring the connections of a microprocessor, memory and I/O chips of the telephone-

computer through configuration code. Applicant respectfully submits that mere use of the term "reconfiguring" with a PGA in Kawan does not result in any teaching or suggestion of the recited invention.

In the present invention, a consumer product in the embedded system market is provided through adaptive silicon and a digitation file. The value of the adaptive silicon is relative to the digitation file, since it is actually the digitation file that determines the configuration that the hardware takes to perform desired operations. The hardware and software are substantially one. In contrast to Applicant's recited digitation file, Kawan specifically discloses that the reconfiguration code only "defines the state of the programmable gate array (PGA)" (Col. 13, lines 24-26) but offers no teaching or suggestion that such state definition establishes a software application to provide an electronic product. Accordingly, Applicant respectfully submits that the reconfiguration code of Kawan pointed by the Examiner fails to teach, show, or suggest the recited digitation file.

Further, there is nothing in Kawan to teach or suggest that procurement of its reconfiguration code is required or that its reconfigurable PGA and reconfiguration code are offered as two separate consumer items. In fact, Kawan discloses that the telephone-computer system can be provided without the reconfigurable PGA and thus without need for the reconfiguration code at all in Col. 11, lines 24-26, which states that the initial program configuration can be fixed using PLA chips instead of the reconfigurable PGA chip. Thus, Applicant respectfully submits that Kawan fails to teach, show, or suggest the recited required procurement of a digitation file of claim 1 or the recited offering of an electronic product as two separate consumer items, an adaptive silicon portion and a digitation file, of claim 8.

In view of the foregoing, Applicant respectfully submits that Kawan fails to teach, show, or suggest the recited invention of independent claims 1 and 8. Claims 2-7 and 9-13 depend directly or indirectly on claims 1 or 8 and are respectfully submitted as allowable for at least those reasons stated hereinabove with respect to claims 1 and 8. With more particular regard to claims 4 and 10, Applicant respectfully submits that given the deficiencies of Kawan with respect to the recited adaptive silicon and digitation file, the disclosure of a test system for use with a cellular telephone in Ryan is insufficient to overcome these deficiencies and result in any teaching or suggestion of Applicant's recited invention in claims 4 and 10. Thus, Applicant respectfully submits that claims 1-13 are allowable over the cited art and respectfully requests withdrawal of the rejections under 35 U.S.C. 102(b) and 103(a).

With regard to the double-patenting rejection over reference 6,237,029, the Examiner asserts that the recitation of an adaptable hardware device providing configurable logic "(i.e., digitation file)" in claims 1 and 36 of 6,237,029 encompass the scope of Applicant's claims 1 and 8. Applicant respectfully disagrees. Applicant fails to see that the configurable logic of 6,237,029 establishes a hardware designation and software application for adaptive silicon, as does the digitation file recited in Applicant's claim 1. Applicant further fails to see that the configurable logic and adaptable hardware device are recited as being offered as two separate consumer items, as recited in Applicant's claim 8. Accordingly, Applicant respectfully submits that claims 1 and 36 of 6,237,029 do not encompass the scope of Applicant's claims 1 and 8. In view of the foregoing, Applicant respectfully requests withdrawal of the double-patenting rejection.

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

SAWYER LAW GROUP LLP

February 10, 2004
Date

Stephen G. Sullivan
Attorney for Applicant(s)
Reg. No. 38,329
(650) 493-4540